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09/898,697	07/02/2001	Hiroaki Shinohara	50R4616	2441

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08/25/2005

EXAMINER

CHANG, SHIRLEY

ART UNIT PAPER NUMBER

2614

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,697

Applicant(s)

SHINOHARA, HIROAKI

Examiner

Shirley Chang

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Response to Amendment

The declaration filed on 6/13/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Thomsen reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Thomsen reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In particular, each and every element was not shown. For example, the provided evidence fails to show each and every element of the claim, specifically, the step of "automatically accessing..."

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Thomsen reference to either a constructive reduction to practice or an actual reduction to practice. In particular, there is an insufficient showing of evidence for the entire period.

Response to Arguments

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed June 13, 2005 have been fully considered but they are not persuasive in view of the declaration being insufficient to overcome the rejection

Art Unit: 2614

with respect to claims 7-20 in view of the aforementioned declaration being insufficient to overcome Thomsen.

The provided evidence fails to show each and every element of the claims, specifically, the step of "automatically accessing..."

Evidence directed to diligence does not show each and every element of the claim. Applicant does not provide a showing for each and every day for the entire period for which diligence is required.

With respect to the applicant's argument as to the provisional application of Thomsen, the examiner notes that the applicant has provided no specific argument as to the support of the provisional.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen (20020067428) in view of Kyne et al. (6615237).**

Art Unit: 2614

As to claim 1, Thomsen discloses a TV (Figure 1 [0024]); a processor coupled to the TV and receiving televised closed captioning content, the processor accessing at least one site in the network based at least partially thereon (a combination of "certain modules of software, microcode, and hardware" [0029]; the controller 116 sends "signals to a cathode ray tube" [0027]; receives "closed caption" [0025] and "transmits instructions to the external device to search for content that contains or matches the second buffer's content" and "displays the result that are provided by the external device" [0031]). Thomsen also discloses that the caption module can "relate the on-screen selected word(s) to closed caption data stored in a caption buffer memory" [0031], where the "viewer...highlights individual symbols on the television display" [0042]; and then the "video controller 116 activates a viewing program on the television so as to allow the viewer to view and access the data that is returned by the data warehouse [0050] (claimed "accessing at least one site in the network based at least partially on the selected portion"). Although Thomsen does not specifically disclose "the processor accessing a Web site associated with a term in the closed captioning by prepending "www." and appending ".com" to the term to render a Uniform Resource Locator (URL) that a browser associated with the processor can use to access the Web site," Kyne teaches "Certain web browsers attempt to convert a text entry into a valid web address by adding, for example, "http://", "www.", or ".com" where necessary to generate a complete URL. However, this URL may not necessarily represent what the user desired. For example, modifying a cartoon character name to be a complete URL might result in retrieving a web page that is inappropriate for children (e.g., a web site

Art Unit: 2614

containing adult-oriented subject matter)" [1, 51-58]; "After the user has entered the text string, the procedure determines whether the text string identifies a web page (block 204). For example, the procedure may determine that the text string identifies a web page if the text string begins with the characters "http://". Furthermore, the procedure may determine that the text string identifies a web page if the text string contains periods along with a particular prefix (e.g., "www") or a particular suffix (e.g., "com", "edu", or "org"). For example, the text string "acme.com" or "www.acmebrush" is considered to identify a web page. If the text string identifies a web page, then the identified web page is retrieved and displayed using the web browser application (block 206). The procedure may modify the text string as needed to create a valid URL. For example, the text string "www.acmebrush" would be modified to "http://www.acmebrush.com" (adding "http://" at the beginning and adding ".com" to the end of the text string), which represents a valid URL" [6, 29-63]. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Thomsen reference with the claimed limitation, as taught by Kyne et al., so as to allow "automatic search for a web page based on information entered in an address box of a web browser and automatically modifying a web page address in certain situations" [1, 33-63].

As to claim 2, the caption module can "relate the on-screen selected word(s) to closed caption data stored in a caption buffer memory" [0031], where the "viewer...highlights individual symbols on the television display" [0042] (claimed "processor receiving a viewer selection portion of the closed captioning content"); and

Art Unit: 2614

then the "video controller 116 activates a viewing program on the television so as to allow the viewer to view and access the data that is returned by the data warehouse [0050] (claimed "accessing at least one site in the network based at least partially on the selected portion").

As to claim 3, the viewer can "use a 'caption selection' button on the keypad 120 or on the remote control 140 to initiate caption selection" [0040] (claimed "input device manipulable to establish selected portion).

As to claim 4, the "data storage for storing closed captioning content" is met when the "video controller 116 copies the highlighted text to a find buffer" [0048].

As to claim 5, the claimed processor accessing "a wide area network search engine" and inputting portions of selected closed captioning content is met by the "video controller 116 formatting the content of the data in the find buffer for transmission to a data warehouse" such as an "Internet search engine" [0049].

As to claim 6, the claimed "processor accessing a wide area network site using a URL derived at least in part from the selected portion" is met as shown in Figure 10. The caption selected search term is "EPA" and as shown in the address toolbar <http://www.altavista.com/cgi-bin/query?pg=q&k=XX&q=EPA>, the search term EPA is used to generate the URL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2614

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen (20020067428) in view of Kyne et al. (6615237).

As to claim 7, the claimed "receiving of closed captioning at a TV receiver" is met as discussed in claim 1. The claimed "receiving of at least one viewer selection..." is met as discussed in claim 2. The claimed "automatically accessing the network site..." is met when the "video controller 116 activates a viewing program on the television so as to allow the viewer to view and access the data that is returned by the data warehouse" where for example, "the viewing program is an Internet browser" [0050].

As to claim 8, the claimed "act of receiving...by a remote control signal" is met as described in claim 3.

As to claim 9, the claimed storing of closed captioning is met as discussed in claim 4.

As to claim 10, the claimed "accessing of a search engine" and "inputting as a search term..." is met as described in claim 5.

As to claim 11, the "accessing a wide area network..." is met as discussed in claim 6.

As to claim 12, the claimed "means for receiving the televised content..." is met as described in claim 1, wherein the "closed caption box 204 includes a plurality of symbols 206, including text, numbers, punctuation characters, graphical characters"

Art Unit: 2614

[0025] (claimed "content including alpha-numeric characters"). The claimed "means for receiving a viewer selection..." is met as discussed in claim 2, and the claimed "means for responsive to viewer selection..." is met as discussed in claim 7.

As to claim 13, the claimed "means for storing..." is met as discussed in claim 4.

As to claim 14, the "means for accessing access a search engine..." is met as discussed in claim 5.

As to claim 16, the claimed closed captioning is met as discussed in claim 12.

As to claim 17, the claimed a closed captioning window is met by the "closed caption box 204" [0025].

As to claim 18, the claimed viewer selection is met as discussed in claim 3.

As to claim 19, the claimed TV is met as discussed in claim 1.

As to claim 20, the claimed processor is met as discussed in claim 1.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Brodsky (US 5,809,471) reference discloses a system and method for selecting portions of closed caption content, and using that content as terms in a wide area network search engine.
- The Osaku et al. (6061738) reference discloses

- The Dickelman (6529187) reference discloses a method and apparatus for converting a sequence of numbers on a telephone keypad of an Internet enabled phone into a desirable location on the World Wide Web.
- The Tsai (5838458) reference discloses a method and apparatus for linking designated portions of a received document image with an electronic address.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5 M-F.

Art Unit: 2614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC

A handwritten signature in black ink, appearing to read 'J. Miller', with a long horizontal flourish extending to the right.

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600